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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,879	09/30/2003	Alan P. Giorgi	HSJ920030177US1	8101

7590 01/24/2007
Marlin Knight
Hoyt & Knight
PO Box 1320
Pioneer, CA 95666

EXAMINER

FLETCHER III, WILLIAM P

ART UNIT	PAPER NUMBER
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1762

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/676,879	Applicant(s) GIORGI ET AL.	
	Examiner William P. Fletcher III	Art Unit 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment and remarks filed January 4, 2007 are noted.
2. Claims 1-16 remain pending.

Response to Arguments

3. Applicant's arguments, see the remarks, filed January 4, 2007, with respect to the rejection of claims 1-16 in paragraph 5A of the prior Office action, have been fully considered and are persuasive. The examiner concurs that "thin film" is a sufficiently definite, art-recognized term. The rejection has been withdrawn.
4. Applicant's arguments, see the remarks, filed January 4, 2007, with respect to the rejections of claims 1-16 in paragraphs 5B-F of the prior Office action, have been fully considered in light of applicant's amendment and are persuasive. The rejections have been withdrawn.

Allowable Subject Matter

5. The indicated allowability of claims 1 and 9 is withdrawn. Further consideration of applicant's disclosure necessitates the grounds of rejection which follow.
6. It remains the examiner's position that the prior art neither teaches nor suggests the timing and application of the lubricant as determined by timestamps as claimed.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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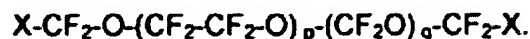
8. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the application of a Z-TETRAOL lubricant, having a linear perfluoropolyether backbone, and the general structure shown at 3:21 of the instant specification, does not reasonably provide enablement for the *any and all* lubricants encompassed by the scope of the claims. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

A. Independent claims 1 and 9 recite: "applying a lubricant to the disk." The scope of this limitation is clearly open to any and all known lubricants.

B. With respect to the lubricant, the instant specification discloses that the invention concerns only "certain lubricants" (2:12, 15) which implies that the invention excludes (i.e., does not concern, is non-functional for, etc.) other lubricants.

C. The instant specification gives, as the only example of a suitable lubricant according to the invention, the following:

The preferred lubricant for use in a system according to the invention is Fomblin Z-TETRAOL which is commercially available from Solvay Solexis, Inc. It is based on a linear perfluoropolyether backbone. The functionalized versions of the "Z" family of lubricants are end capped with two functional groups specifically designed to have a strong interaction with the disk surface. The structure with end caps is given by Solvay Solexis as:



The "X" end groups for Z-TETRAOL are given as:



- D. As such, the instant specification does not give any indication as to what other lubricants are suitable or how such lubricants may be identified. Further, it is the examiner's position that, absent evidence to the contrary, the genus of any and all thin film disk lubricants is sufficiently large and diverse that such a lack of guidance in selecting/identifying suitable lubricants necessitates undue experimentation on the part of one of ordinary skill to practice the claimed invention.
9. Claims 5 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
- A. Claims 5 and 13 have been amended to recite that the lubricant "comprises perfluoropolyether."

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B. As noted above, the specification discloses only Z-TETRAOL lubricants, which are, more narrowly, based on a liner, perfluoropolyether backbone.

C. Consequently, the originally-filed disclosure fails to support the *any and all* perfluoropolyether-containing lubricants recited in these claims, as-amended.

Possession of a species does not, necessarily, support possession of a genus.

Conclusion

10. The prompt development of clear issues in the prosecution history requires that applicant's reply to this Office action be fully responsive (MPEP § 714.02). When filing an amendment, applicant should specifically point out the support for any amendment made to the disclosure, including new or amended claims (MPEP §§ 714.02 & 2163). A fully responsive reply to this Office action, if it includes new or amended claims, must therefore include an explicit citation (i.e., page number and line number) of that/those portion(s) of the original disclosure which applicant contends support(s) the new or amended limitation(s).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 0900h-1700h.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



William Phillip Fletcher III
Primary Examiner
Art Unit 1762

January 18, 2007